

**United States Patent and Trademark Office (USPTO)  
Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 79406047

**Mark:** CAFITESSE

**Correspondence Address:**

**Applicant:** Koninklijke Douwe Egberts B.V.

**Reference/Docket No.** N/A

**Correspondence Email Address:**

**NONFINAL OFFICE ACTION  
Notice of Provisional Full Refusal**

**International Registration No.** 0604678

**Deadline for responding.** The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "IB-1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Discussion of provisional full refusal.** This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). See 15 U.S.C. §§1141f(a), 1141h(c).

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he referenced application has been reviewed by the assigned trademark

examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

## SEARCH RESULTS – NO CONFLICTING MARKS FOUND

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

## SUMMARY OF ISSUES:

- Identification of Goods
- Applicant's Legal Entity
- Email Address Required
- Applicant must be Represented by a U.S.-Licensed Attorney

## IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified according to the explanations and suggestions below. *See* TMEP §1402.01. Some entries are indefinite as they do not identify specific goods. Consequently, applicant must provide additional clarification where indicated below.

Applicant may substitute the following wording, with additions shown in bold and deletions shown as strike through text:

Class 011: Apparatus for preparing and dispensing hot and cold beverages, **namely, {identify specific Class 011 goods}; electric** tea and coffee making machines and apparatus

Class 030: Coffee, ~~also coffee packed in filters;~~ coffee extracts, instant coffee, coffee substitutes; coffee and coffee substitute blends; mixes of

coffee, ~~powdered milk~~ and coffee substitutes; coffee containing cereals, fruits and spices, **for use** as coffee substitutes; tea, tea extracts, tea substitutes; cocoa, chocolate and chocolate extract in powdered, granular or liquid form, all these goods being used for the preparation of **tea-based** drinks; sugar; ~~the other classes remain unchanged~~

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applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods not found or encompassed by those in the original application or as acceptably narrowed. *See* TMEP §1402.06(a)-(b). The scope of the goods sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods will further limit scope, and once goods are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual*. *See* TMEP §1402.04.

## **APPLICANT'S LEGAL ENTITY**

Applicant must specify its legal entity type and national citizenship or foreign country of organization or incorporation, as applicant did not include this information in the application. *See* 37 C.F.R. §§2.32(a)(3)(i)-(v), 2.61(b); TMEP §§803.03, 803.04. This information is required for all U.S. trademark applications, including those filed under Trademark Act Section 66(a). *See* 37 C.F.R. §7.25(a)-(b); TMEP §1904.02(a).

Acceptable legal entity types include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. *See* TMEP §§803.03 *et seq.* If applicant's legal entity type is an individual, applicant must so specify and provide his or her national citizenship. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.03(a). If applicant is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must so specify and provide the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(b)-(c). For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the *Trademark Manual of Examining Procedure* (TMEP). TMEP §803.03(c). If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. *See* TMEP §803.04.

## **EMAIL ADDRESS REQUIRED**

Applicant must provide applicant's email address, which is a requirement for a complete application. *See* 37 C.F.R. §2.32(a)(2); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. *See* TMEP §803.05(b).

## **APPLICANT IS REQUIRED TO BE REPRESENTED BY A U.S.-LICENSED ATTORNEY TO RESPOND TO OR APPEAL THE PROVISIONAL REFUSAL**

Applicant's domicile is located outside of the United States and applicant does not appear to be represented by a qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories must be represented by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §2.11(a); TMEP §§601, 601.01(a). In this case, applicant's domicile is identified in the application as outside of the United States or its territories. For more information, see the U.S. Counsel webpage at <https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us> and Hiring a U.S.-licensed trademark attorney webpage at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney>.

To appoint a U.S.-licensed attorney in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/ccr/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> indicating that an appointment of attorney has been made and address all other refusals or requirements in this action. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. *See* 37 C.F.R. §2.17(b)(1)(ii); TMEP §604.01.

**Response guidelines.** For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see the [Responding to Office Actions](#) webpage for more information and tips on responding.

Please email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

**How to respond. [Click to file a response to this nonfinal Office action.](#)**

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## RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

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